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Attorney Docket No. 394-137

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Craig Novak et al.

Art Unit 3632

Serial No.: 09/909,423

Examiner: Sterling, Amy Jo

For: Decorative Gift Bag Balloon Holder

Filed: July 19, 2001

January 6, 2003

SUBMISSION OF BRIEF ON APPEAL

Hon. Commissioner of Patents
and Trademarks
Washington D.C. 20231

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GROUP 3600

Pursuant to Rule 192, applicant submits three copies of its Brief On Appeal.

A check for the fee of \$160.00 for the filing of the brief is enclosed herewith. Please charge any further fee due in connection with this application to deposit account no. 04-1797.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington D.C. 20231, on January 6, 2003.

January 6, 2003

Gerard F. Dunne

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This brief is being submitted in triplicate to The Board of Patent Appeals and Interferences in support of the appeal in the above-captioned matter. This appeal is from the final decision of the Examiner dated July 30, 2002 finally rejecting claims 1-16, all the claims in the application.

1. Real party In Interest

The application has been assigned to the real party in interest, Unique Industries, Inc. of 2400 S. Weccacoe Avenue, Philadelphia, Pennsylvania 19148.

2. Related Appeals and Interferences

No cases are known which will directly affect or be directly affected by or have a bearing on any decision by the Board in this appeal.

3. Status of Claims

The application presently contains claims 1 through 16. Claims 1 through 16 had been subject to a final rejection in the action of July 30, 2002 and are involved in this appeal.

This appeal involves all the claims in the application. No claims have been cancelled.

4. Status Of Amendments

An amendment to the specification was presented under Rule 116 and directed to a correction of a minor typographical error. This amendment was filed shortly before the filing of the appeal brief.

5. Summary Of Invention

The present invention relates to a decorative balloon holder for securing one or more buoyant balloons in position on a tabletop or the like during festive occasions. Various devices for holding a buoyant party balloon in a desired position on a tabletop have been proposed, but such products are often not very attractive for use at a festive occasion such as a birthday party, or are relatively expensive to manufacture.

As acknowledged by applicants in the specification (see, page 3, lines 4-10 in the specification as filed), balloon holders formed of a small gift bag having a weight such as small lead fishing weights or sand placed in the bottom of the gift bag had been used with decorative tissue paper placed loosely inside to cover the weight. Such balloon holders simulating a gift bag are festive and very desirable for many party occasions where buoyant balloons need to be held in place on a tabletop or the like.

However, such balloon holders simulating a gift bag are typically made individually

as craft items, and are not manufactured readily by automatic techniques. Further, such craft item balloon holders are difficult to ship, or to store or display effectively in a retail environment and have not, therefore, become commercial items that can be mass distributed.

By the present invention, the applicants provided a decorative balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder.

Fig. 1 of the application illustrates a party balloon 10 having a string 12 tied to handles 14 of a decorative gift bag 16 forming part of a balloon holder 18 of the first embodiment of the present invention. The balloon holder 18 illustrated in Fig. 1 as resting on a tabletop 20 and has sufficient weight to counteract the buoyancy of one or more balloons 10.

As shown in Fig. 2 of the application, a core 22 formed of an inexpensive but weighty material such as compressed sand held by an adhesive; or a sand, cement and water mixture, is formed into a shape corresponding to the interior of the gift bag. Decorative material is provided to extend outwardly from the open top of the gift bag 16, and the decorative material is formed from a length 24 of decorative sheet material having its upper portion 28 cut into a series of strips 30.

The lower portion 32 of the decorative material is held around the periphery of the core 22 by orthogonal strips of tape 34 and 36. In this way, the decorative material is held to the core 22 around its generally rectangular periphery to conceal the inner core 22 from casual view by forming a decorative effect about the rectangular opening in the top of the gift

bag 16 when the strips 30 are arranged to extend outwardly from the open gift bag 16.

The core 22 is preferably adhered to the bottom 38 of the gift bag 38 by an adhesive, tape or the like to secure the assembly together, and the upper portions of the handles 14 are preferably secured together by adhesive, tape, fine line or the like. By holding the decorative material to the core 22, as well as by securing the upper portions of the handles together, the assembled balloon weight will be held together during shipment, storage or handling. A decorative balloon holder simulating a gift bag is thus suitable to be shipped securely, and handled at retail while maintaining its attractiveness to the consumer.

Fig. 3 illustrates a second embodiment of the present invention having a larger gift bag 40. As shown in Fig. 4, an inner liner 41 conforming generally to the shape of the interior of the gift bag 40 is fitted within the gift bag 40. The inner liner may be formed of cardstock and is folded into shape and secured by tape 41a.

The core 42 of the second embodiment is preferably wrapped in protective paper 43 secured by tape 44, and the core 42 is held to the interior of the lower portion 46 of the inner liner 41 by one or more strips of tape 48 engaging the bottom of the wrapped core 42 and the sides of the inner liner 41. The decorative material 50 formed in a manner similar to the decorative material 30 of the first embodiment is held to the interior of the upper periphery 52 of the inner liner 41.

By use of the inner liner 41, a balloon weight formed of a larger size gift bag will have support to maintain its decorative shape and assemblage during handling and shipment. As in the first embodiment, the upper portions of the handles 14 may be secured together by

adhesive, tape, fine line or the like to complete the assemblage.

6. Issues

A. Whether the Examiner properly followed the relevant law in rejecting the claims 1 through 3, 8, 9 and 14 under 35 U.S.C. § 103 without considering the problems solved by the applicants because the problems solved were not themselves recited in the claims.

B. Whether the Examiner properly rejected under 35 U.S.C. § 103 claims 3 through 6, 8 through 10 and 14 requiring the decorative layer be cut into strips but held to the core in view of a patent to Valentino that does not suggest securing cut strips of paper to the periphery of a weighted core as expressly required in these claims.

C. Whether the Examiner properly rejected the claims 8 through 13 under 35 U.S.C. § 103 directed to the second embodiment requiring the liner when the applied art does not describe such liner as recited in the claims.

7. Grouping of Claims

A. The rejection of claims 1 through 3, 8 and 9 under 35 U.S.C. § 103 in view of the internet *Fun Place* reference in view of the Valentino patent does not stand or fall with the rejection of any single claim. Claim 2 recites the feature of the core being secured to the interior of the decorative bag, and this feature is neither disclosed nor suggested by the applied references. Claims 3 and 9 require the decorative sheet material having its lower portion secured around the periphery of the core, and this feature is neither disclosed nor suggested by the applied references.

Claims 8 and 9 require the addition of an inner liner as disclosed for the second

embodiment of the present invention, and this feature is neither disclosed nor suggested by the applied references.

B. The rejection of claims 1 through 16 under 35 U.S.C. § 103 in view of the internet *The Party Balloon* reference in view of the Valentino patent does not stand or fall with the rejection of any single claim. Claim 2 recites the feature of the core being secured to the interior of the decorative bag, and this feature is neither disclosed nor suggested by the applied references. Claims 3 and 9 require the decorative sheet material have its lower portion secured around the periphery of the core, and this feature is neither disclosed nor suggested by the applied references. Claims 5, 7, 11, 13 and 16 require a balloon holder with the handles that are to serve as an attachment for a string of one or more balloons to be secured together. *The Party Balloon* reference does not disclose a balloon holder with the handles being secured together to serve as an attachment for a string of one or more balloons as defined in the claims.

Claims 8 and 9 require the addition of an inner liner as disclosed for the second embodiment of the present invention, and this feature is neither disclosed nor suggested by the applied references.

8. Argument

A. The rejection of claims 1 through 3, 8, 9, and 14 under 35 U.S.C. § 103 in view of the internet *Fun Place* reference in view of the Valentino patent.

The Examiner has acknowledged that the combination of the internet *Fun Place* reference and the Valentino patent would not produce a structure as required in claim 1 (the

only independent claim) of having the decorative material secured to the core, or securing the core to the bag as required in claim 2. The Examiner stated in the final action:

How the balloon holder is made, stored or displayed is not given as a positive limitation in the claims nor is it even mentioned in the claims as an intended use of the balloon holder, so these purported uses of the item have been given no weight. See, page 3, lines 3-6 of page 3 of the final action of July 30, 2002.

It is respectfully submitted that the Examiner is required to consider the invention "as a whole" in evaluating patentability under 35 U.S.C. § 103. *Hodosh v. Block Drug Co. Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187, n.5 (Fed. Cir.1986). As noted in *In re Sponnobile*, 405 F.2d 578, 585, 160 U.S.P.Q. 237 (CCPA 1969):

A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. Although we believe that appellant, here, has actually done more than this in making his combination, we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to look further as to the reasons for making the combination.

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in

determining the obviousness of an invention under 35 U.S.C. § 103. In re Antonson, 272 F.2d 948, 47 CCPA 740; In re Linnert, 309 F.2d 498, 50 CCPA 753. The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. In re Murray, 268 F.2d 226, 46 CCPA 905; In re Sporck, 301 F.2d 686, 49 CCPA 1039. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. In re Leonor, 395 F.2d 801, 55 CCPA 1198. 405 F.2d at 832-33.

The Examiner took judicial notice that tape may be used to secure items to their desired locations, and in so holding to reject claims improperly ignored the mandate of the Federal Circuit that “[a] patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use” and that “a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified.”

Applicants have identified a source to the problem of providing a commercially viable decorative balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder. The solution of securing the decorative material to the core (claim 1) or securing the core to the interior of the bag (claim 2) by tape may be obvious after the solution is proposed

by applicants, and such is not sufficient to reject applicants' claims.

In *In re Spinnobile*, 405 F.2d at 833 the court stated:

Applying these principles to the case at bar *and by reference to appellant's specification*, we find a clear indication that he discovered the source of the problem... (Emphasis added)

By failing to consider the problem solved by applicants and by holding "[h]ow the balloon holder is made, stored or displayed is not given as a positive limitation in the claims nor is it even mentioned in the claims as an intended use of the balloon holder, so these purported uses of the item have been given no weight" was clear error by the Examiner. The Examiner is required to make reference to the specification in considering the invention as a whole and the problem solved by the applicants.

Further, the Valenino patent discloses inserting a flat platform 16 in the bottom of a gift bag (col. 2, lines 42-45) and does not disclose securing the flat platform to any "core" as required in claim 1. Certainly, the Valentino reference does not disclose the decorative sheet material having its lower portion secured around the periphery of the core, as required in claims 3 and 9. Claims 8 and 9 require the addition of an inner liner as disclosed for the second embodiment of the present invention, and this feature is neither disclosed or suggested by the applied references.

There is, moreover, no motivation from the Valentino patent to secure his flat platform to a weighted core of a balloon weight. The Examiner has not suggested any motivation or suggestion *from the references* to secure the flat platform of the Valentino

patent to a balloon weight core as claimed.

The Examiner is reconstructing features of the claims from isolated elements of the prior art with the only teaching to do so being applicant's disclosure. Such hindsight reconstruction of the claimed invention is improper. The rejection of claim 1 and the claims depending therefrom is improper under the guidelines of M.P.E.P §2143.01.

With regard to rejecting a claim by substituting an element from one reference to another, "it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972). What teachings are found *in the references* for taking the flat platform of the Valentino patent and securing it to a balloon core?

Combining elements of the art to produce the claimed invention is proper only where there is some teaching, suggestion, or motivation to do so found either in the references themselves, or in the knowledge generally available in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner has relied on impermissible hindsight in making the rejection based upon obviousness. "It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps". *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). The Examiner has combined isolated features from the references to reconstruct

what he interprets as applicant's claimed invention with the motivation for the combination being applicant's own disclosure or claim language. Such actions by the Examiner violate the strictures of *In re Fritch* in reconstructing the claimed invention by selecting bits and pieces from the prior art by using applicant's disclosure as a guide.

The law is clear that the mere fact that the references can be combined to meet the invention claimed does not render the resultant combination obvious under the Statute unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir 1990). The fact the aspects of the invention may be individually known in the art does not make their combination obvious under the Statute without some reason from the art for the combination of elements proposed by the Examiner. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (PTO Bd. Pat. App. & Inter. 1993). It is also improper to rely upon the level of skill in the art to provide the suggestion to combine features of different references. *Al-Site Corp. v. VSI Intl. Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Applicant has provided a device which solves the problem of providing a commercially viable decorative balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder. Although the solution of applicant's invention may appear simple in hindsight, such simplicity is no basis for rejection. *In re Horn, Horn, Horn and Horn*, 203 U.S.P.Q. 969 (CCPA 1979) and cases cited at page 971.

B. The rejection of claims 4, 6, 10, 12, 15 under 35 U.S.C. § 103 in view of the internet *Fun Place* reference in view of the Valentino and Harms patents.

For the reasons noted above in connection with the independent claim 1 and the claims from which claims 4, 6, 10, 12, and 15 depend, these dependent claims have been rejected improperly.

C. The rejection of claims 1 through 16 under 35 U.S.C. § 103 in view of the internet *The Party Balloon* reference in view of Valentino.

To the extent the Examiner relies upon the rejection of claims 1-4, 6, 8-10, 12, 14 and 15, please note the comments made above. The Examiner has rejected claims 5, 7, 11, 13 and 16 by noting *The Party Balloon* publication shows handles of a bag secured together.

However, *The Party Balloon* publication illustrates a bouquet of balloons held to a decorative gift bag with the balloon strings (or tie ribbons) held to the handles of the gift bag. This reference, therefore, teaches tying the balloon strings to the handles of a gift bag.

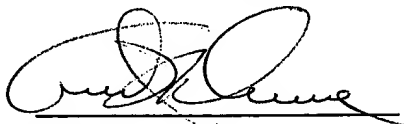
The claims 5, 7, 11, 13 and 16 depend from respective claims that recite “said decorative bag having handles extending from an upper portion thereof to serve as an attachment for a string of one or more balloons.” The handles that are recited to be secured together in claims 5, 7, 11, 13 and 16 are, therefore, handles that will *in the future* serve as attachment for a string of one or more balloons, not handles secured together by attaching the string of one or more balloons.

The Party Balloon publication does not suggest securing together handles that will in the future serve as an attachment for a string of one or more balloons as required in claims

5, 7, 11, 13 and 16. The combination proposed by the Examiner would not meet the limitations defined in these claims.

It is, therefore, request the Board reverse the rejections made by the Examiner.

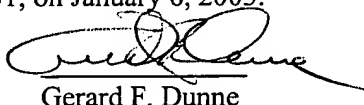
Respectfully submitted,



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January 6, 2003



Gerard F. Dunne

APPENDIX—CLAIMS ON APPEAL

The claims on appeal are:

1. A balloon holder, comprising a decorative bag, a core having sufficient weight to hold at least one buoyant balloon in place and positioned within said decorative bag, and decorative material secured to said core in a position to conceal said core from casual view.
2. A balloon holder as set forth in claim 1, said core being secured to the interior of said decorative bag.
3. A balloon holder as set forth in claim 2, said decorative material being formed from a length of decorative sheet material having its upper portion cut into a series of strips adapted to extend outwardly from said decorative bag and its lower portion secured around the periphery of said core.
4. A balloon holder as set forth in claim 3, said decorative bag having handles extending from an upper portion thereof to serve as an attachment for a string of one or more balloons.
5. A balloon holder as set forth in claim 4, the upper portions of said handles being secured together.
6. A balloon holder as set forth in claim 2, said decorative bag having handles extending from an upper portion thereof to serve as an attachment for a string of one or more balloons.
7. A balloon holder as set forth in claim 6, the upper portions of said handles being

secured together.

8. A holder for a balloon as set forth in claim 1, including an inner liner fitted within said decorative bag, said core being held to the interior of the lower portion of said inner liner and said decorative material being held to the interior of the upper periphery of said inner liner.

9. A balloon holder as set forth in claim 8, said decorative material being formed from a length of decorative sheet material having its upper portion cut into a series of strips adapted to extend outwardly from said decorative bag and its lower portion held around the interior of the upper periphery of said inner.

10. A balloon holder as set forth in claim 9, said decorative bag having handles extending from an upper portion thereof to serve as an attachment for a string of one or more balloons.

11. A balloon holder as set forth in claim 10, the upper portions of said handles being secured together.

12. A balloon holder as set forth in claim 8, said decorative bag having handles extending from an upper portion thereof to serve as an attachment for a string of one or more balloons.

13. A balloon holder as set forth in claim 12, the upper portions of said handles being secured together.

14. A balloon holder as set forth in claim 1, said decorative material being formed from a length of decorative sheet material having its upper portion cut into a series of strips

adapted to extend outwardly from said decorative bag and its lower portion held within said decorative bag.

15. A balloon holder as set forth in claim 1, said decorative bag having handles extending from an upper portion thereof to serve as an attachment for a string of one or more balloons.

16. A balloon holder as set forth in claim 15, the upper portions of said handles being secured together.

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